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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/795,905	03/08/2004	Jerry H. Roberts	20002.120	1531

7590

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EXAMINER

KENNEDY, SHARON E

ART UNIT

PAPER NUMBER

3767

DATE MAILED: 12/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/795,905

Applicant(s)

ROBERTS ET AL.

Examiner

Sharon Kennedy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

### **DETAILED ACTION**

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action or the MPEP.

#### ***Claim Rejections - 35 USC § 112***

Claims 1-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant now claims that the bandage is "laminar", which is not found in the original specification and appears contradictory to the original figures, especially figure 5, and the disclosure. According to the disclosure, applicant's device contains "a center portion 20 ... formed of a fabric, light weight cellular material or similar conformable material, to act as a cushioning pad adapted to support and space a catheter and/or medical tubing a distance from a patient's skin." [Emphasis added.]

Normally the examiner would permit such an entry, and merely object the specification to having a lack of antecedent basis. However, applicant is trying to hinge patentability on this feature. Accordingly, it must be intimately disclosed in order to provide guidance to potential infringers.

#### ***Claim Rejections - 35 USC § 102***

Claims 1-7, 9, 11-14 are rejected under 35 U.S.C. 102(b) as being clearly anticipated Kornerup, US 5,685,859. See figure 6 and the description therein. Note that elongate strip 143 flanks both sides of elongated section 160. Note that groove 165 may be provided with adhesive thereon. See Kornerup column 7, lines 21-23.

### ***Claim Rejections - 35 USC § 103***

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kornerup, US 5,685,859 in view of Bierman, US 6,689,104. Regarding claim 8, it would be an obvious engineering design choice to provide removable release liner on any adhesive coated surface in a bandage type appliance. In addition, note Bierman shows this concept is well known. See release layer 26 on the front page of the patent.

### ***Allowable Subject Matter***

Claim 10 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

### ***Response to Arguments***

Applicant's arguments filed November 25, 2005 have been fully considered but they are not persuasive. The thrust of applicant's arguments is that applicant's invention is "laminar". First, this is not found in the original specification. Certainly

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applicant's bandage is generally flat, but so is the Kornerup device. Applicant's device contains "a center portion 20 ... formed of a fabric, light weight cellular material or similar conformable material, to act as a cushioning pad adapted to support and space a catheter and/or medical tubing a distance from a patient's skin." [Emphasis added.] The examiner doesn't see any difference between what is shown by applicant's figures and the Kornerup disclosure. Applicant should also be aware that the figures often exaggerate a feature to give it emphasis. In other words, drawings are not always to scale. In this regard, applicant should review the case law set forth in MPEP 2125. Further, novelty and patentability cannot hinge on a concept that hasn't been disclosed. If "laminar" is a critical, and applicant's foam pad must be distinguished from prior art foam pads for this reason alone, then there should have been some discussion regarding it in the original specification so that potential infringers can understand the scope of the claim. Finally, the arguments concerning the center portions are seen as merely word play. How do the "ends," "sides," "longitudinal directions" distinguish from Kornerup? If applicant wants to amend the claims to that applicant's cushioning foam pad is "consisting of a square," perhaps the arguments would be more convincing.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

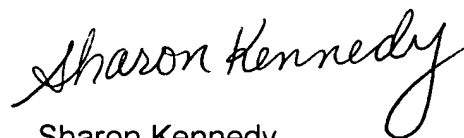
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

#### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharon Kennedy whose telephone number is 571/272-4948. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on 571/272-6996.

Information regarding the status of an application may be obtained by going to [www.uspto.gov](http://www.uspto.gov), clicking on "Status & IFW", entering the application number, and then clicking on one of the tabs to retrieve the appropriate information.



Sharon Kennedy  
Primary Examiner  
Art Unit 3762